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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/926,277	09/05/1997	PAUL F VACHRIS		6715

7590 05/31/2002

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EXAMINER

ROSENBERGER, RICHARD A

ART UNIT	PAPER NUMBER
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2877

DATE MAILED: 05/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**08/926,277**

Applicant(s)  
**VACHRIS et al**

Examiner  
**Richard Rosenberger**

Art Unit  
**2877**



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 4, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 64-96 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 64-96 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

1. As set forth below, there are two distinct invention being claimed in this application. Review of the claims, rejections, references, and arguments in the prosecution history of this application has shown that orderly prosecution appears to have been compromised and confusion has resulted from the presence of claims to two separate inventions in this application. Therefore restriction appears to be proper.

Several actions treating both inventions in this and parent applications have been issued without restriction having been previously made. The patent statutes and rules do not require restriction when there is more than one invention; when there is no particular reason to require restriction for orderly prosecution a restriction requirement, although otherwise proper, need not be made. However, it has become clear to the examiner in this case that the initial belief that the two inventions could be properly be treated in a single application was mistaken, and that the prosecution has become overly complex and confusing due to the presence of more than one invention, and it appears that situation is likely to continue. Thus restriction is now being made. The delay in making the requirement is regretted.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 64-79, drawn to a system, apparatus and method for  
generating an image of a relief object having an electroluminescent

device having two electrodes, one being flexible, with a variable resistive layer underlying the flexible electrode, classified in class 356, subclass 71.

- II. Claims 82-96, drawn to a system, apparatus and method for generating an image of a relief object having an electroluminescent device having only one electrode, with the relief object itself being used as the second electrode, classified in class 356, subclass 71.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, although directed to the same end of generating an image of a relief object, operate in different manners using different structural arrangements. Invention I uses a flexible electrode and variable resistive layer while invention II has neither of these features. Invention II uses the relief object itself as an electrode, which invention I does not. The two are not usable together, but are alternative, and different, ways of accomplishing their common end.

Further, the two are distinct; the unpatentability of one does not imply the unpatentability of the other. The use of a flexible electrode and variable resistive layer as claimed in invention I does not imply the unpatentability of the use of an electroluminescent system with only one electrode with the relief object itself being used as the second electrode, and the use of the relief object as the second electrode does not imply the unpatentability of the use of a flexible electrode and variable resistive layer.

Because the subject matter of the two inventions is patentably distinct, the issues involved in the examination of each are different from the issues involved in the examination of the other, as well as the references that are particularly relevant to one need not be, and in the proceeding action were not, the same.

For these reasons the orderly prosecution of this application appears to require restriction to separate the two and simplify the prosecution, which appears to have become overly complex and confusing due to the presence of two distinct and unrelated inventions being simultaneously prosecuted in this application.


4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Papers related to this application may be submitted to Group 2800 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The fax number is (703) 308-7722.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. A. Rosenberger whose telephone number is (703) 308-4804.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

R. A. Rosenberger  
29 May 2002



Richard A. Rosenberger  
Primary Examiner